

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed April 28, 2004. Applicant amends Claims 1, 6, and 13. The amendments to the claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-3, 13, and 16-21 under 35 U.S.C. §103(a), as being unpatentable over European Patent Application EP 920153 A2 (hereinafter "*Shiragaki*") in view of U.S. Patent No. 5,647,035 issued to Cadeddu et al. (hereafter "*Cadeddu*") and Karasan et al.: an article entitled "Optical restoration at the wavelength-multiplex-section level in WDM mesh networks" (hereinafter "*Karasan*"). The Examiner rejects Claims 6-10 35 U.S.C. §103(a), as being unpatentable over *Shiragaki* in view of *Cadeddu*. Applicant respectfully traverses this rejection for the following reasons.

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations. (See M.P.E.P. § 2142-43.) It is respectfully submitted that these claims are patentable over the art of record based on, at least, the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

For example, as amended, Independent Claims 1, 6, and 13 generally recite a response to a failure condition that is executed on a channel level and an optical ring that includes an optical switch unit that includes a number of switching blocks that is twice a number of protected channels. First, *Cadeddu* nor *Shiragaki* perform such channel level operations. Second, the structure of *Cadeddu* and *Shiragaki* are not capable of maintaining a relationship between the number of switching blocks and the number of protected channels, as identified by Independent Claims 1, 6, and 13. Such operations and capabilities are significant. When the failure control is performed at the channel level, instead of the multiplex level, a number of drawbacks are avoided. For example, by operating protection at the channel level, it is possible to provide

optical protection to a selected subset of optical channels. In addition, because the reconfiguration takes places at the channel level, each node does not have to be provided with switching equipment to perform protection on all the network channels. (See Original Specification for support: pages 5-6.) Note also that because the number of switching blocks is two times the number of protected channels, greater flexibility is provided. For example, the present invention may accommodate any number of switching blocks (e.g. 64-256) in contrast to other systems. (See Original Specification for support: page 6.)

Applicant notes that any combination of *Shiragaki* and *Cadeddu* and some other reference that may disclose a channel level operation would be inappropriate in the context of a future §103 rejection. This is because there is no evidence to suggest that *Shiragaki* and *Cadeddu* would be capable of successfully operating in such a fashion. In addition, there is no evidence to support that either of these references could maintain the relationship between the switching blocks and the protected channels. Moreover, there is no teaching, disclosure, or suggestion to make any such combinations. These essential facts would vitiate the other prongs obviousness and, therefore, render the pending claims allowable.

Thus, Independent Claims 1, 6, and 13 are allowable over *Cadeddu* and *Shiragaki*. In addition, the dependent claims associated with these Independent Claims are also allowable for analogous reasons.

Double Patenting Rejection

Claims 1-3, 6-7, and 13 of the present application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 6, 15, and 22 of co-pending Application 09/750,311 in view of *Shiragaki* and *Karasan*. Applicant has addressed the Examiner's concerns with a number of amendments to claims 1, 6, and 13. Thus, this rejection should be withdrawn. All of the claims are now in condition for immediate allowance. Notice to this effect is respectfully requested by Applicant in the form of a full allowance of the pending claims.

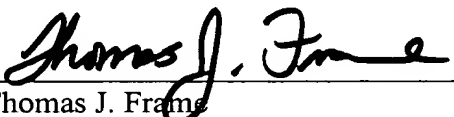
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fees are due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
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